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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,474	02/05/2001	Akiyoshi Yamashita	MAT-8048US	5500

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EXAMINER
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CHOI, WOO H

ART UNIT	PAPER NUMBER
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2186

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/700,474

Applicant(s)

YAMASHITA, AKIYOSHI

Examiner

Woo H. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: The claim recites the limitation “a continuous removable media” in the preamble and refers to this media as “said removable media” and “said continuous removable media” in the body of the claim. While it is not unclear that both limitations refer to the same “continuous removable media” recited in the preamble, Applicant should pick one limitation or the other and use it throughout the claim for consistency and clarity. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. While a **computer readable medium** having a program recorded may be statutory, the claimed “medium having a program recorded” per se is non-statutory because it is not capable of causing functional changes in the computer (see MPEP 2106(IV)(B)(1)(a) page 2100-13).

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 – 9 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The method of creating partitions, as currently stated in claim 1, without the removable media loading and partition checking steps critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim requires that each area reserved, in the reserving step, include information which indicates whether a corresponding partition exists on the removable media. However, this information is not available until the removable media is loaded and checked for existence of partitions (see specification, page 8, lines 13 – page 9, line 2). The disclosed reservation step (figure 2, step S4, and specification, page 6, lines 3 – 10) merely reserves the areas without filling the area with the required information recited in the claim. Thus, the specification does not enable one skilled in the art to reserve partition information areas that includes information which indicates whether a respective partition exists on the removable media without the media loading and partition checking steps.

Claims 2 – 9 are rejected because of their dependence on the parent claim found to be defective as discussed above.

6. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The claim requires that “said removable media is recognized as a plurality of drives, regardless of whether or not said removable media is loaded in said removable device. Closest support for this limitation is found on page 5, line 21 – page 6, line 2. This passage discloses that a device driver stores in the operating system and the file system “a maximum number of partitions that can be handled regardless of whether or not a DVD medium is loaded in the DVD-RAM device 5”, but does not disclose that the removable DVD medium is recognized as a plurality of drives when it is not loaded. On the contrary, it is clear from the specification that non-existent partitions are not recognized as drives (see figure 1, 7, only the existing partitions 7a and 7b are recognized as drives). Partitions do not exist in the removable device until a DVD medium is loaded and the removable DVD medium is not recognized as a plurality of drives unless it is loaded. Applicant is asked to please specifically point out where in the specification the limitations of claim 9 can be found.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 – 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitations "said operating system" and “said one or more drive letters” in line 11 and 16, respectively. There are insufficient antecedent bases for these limitations in the claim. The antecedent bases for these limitations have been deleted by the last amendment.

Claims 2 – 9 are rejected because of their dependence on the parent claim found to be defective as discussed above.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft (Microsoft Windows 95 Resource Kit, 1995).

11. With respect to claims 1 and 5, Microsoft discloses a method of creating partitions in a removable device capable of accepting a continuous removable media (page 652, Assigning Drive Letters for Removable Media, a floppy disk for example, note that the partitions created are partitions in the device, see page 652, drive letter reservation step 4), said method comprising the steps of:

communicating in a computer system capable of connecting with a removable device in order to request an allocation of one or more drive letters to said removable device (see page 652, To reserve drive letters for removable media);

storing a maximum number of partitions that can be allocated in said removable media regardless of whether or not said removable media is loaded in said removable device (page 653,

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the MaxRemovableDrivePartition entry in the Registry or the number determined by the operating system based on the media present when the system starts);

reserving, within an internal work area of said operation system, areas corresponding to said maximum number of partitions (page 648, fdisk command is used to create, delete, set active partition, and display partition information, this requires areas to store information on each partition), each of said areas including information which indicates whether a respective partition exists on said removable media (existence of displayable partition information indicates that a partition exists); and

allocating to said continuous removable media of said continuous removable media said one or more drive letters based on a number of said areas reserved within said internal work area (page 653, first sentence, the MaxRemovableDrivePartition entry in the Registry allocates the drive letters to be used by partitions on removable media).

12. With respect to claims 2 and 7, the number of drives is equal to a maximum number of partitions supported by said operating system (MaxRemovableDrivePartition defines the maximum number of partitions supported by the operating system for a removable device).

13. With respect to claim 3, said drive letters allocated to the single unit of said removable device remain valid until being reallocated again; and

a number of drive letters derived by subtracting a number of partitions on a medium within said removable device from the number of said drive letters is recognized as being absence of any medium (page 653, first paragraph, the number of drive letters is based on the

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number of partition that exists on the media when started; second paragraph, Windows 95 recalculates the disk geometry every time a media change is detected).

14. With respect to claim 4, said drive letters comprise arbitrary characters allocated by an operator (page 652, see procedure 'To reserve drive letters for removable media').

15. With respect to claim 6, the method further comprises the step of using the operating system to allocate to the removable media the plurality of drive letters so that the removable media is divided into partitions corresponding to the number of drive letters (pages 652 – 653, "To reserve drive letters for removable media").

16. With respect to claim 8, said drive letters are sequential with further drive letters allocated to hard disk drives (page 652, drive letters are assignable, they can be assigned to be sequential with other drives, in addition, Windows assign drive letters sequentially when a user does not assign drive letters specifically).

### ***Response to Arguments***

17. Applicant's arguments filed January 3, 2005, have been fully considered but they are not persuasive. Applicant's argument regarding proper support for the limitation "each of said areas including information which indicates whether a respective partition exists on said removable media" is not persuasive because as explained above in the rejection of claim 1, this limitation is part of "reserving" step and the passage identified by Applicant for support is part of "media



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loading and partition checking step". When areas are reserved, the information required by the limitation is not available. It only becomes available after the media is loaded and checked for partitions.

Applicant's argument that "Microsoft completely lacks any disclosure of internal work are in which information is stored indicating whether respective partitions exist" is not persuasive either. As discussed in the rejections above, the Microsoft reference discloses a command and procedures used to create, delete, set active partition, and display partition information. The operating system must store information on each partition in order to perform the partition management procedures. The existence of this information indicates that a partition corresponding to this information exists.


### *Conclusion*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Woo H. Choi whose telephone number is (571) 272-4179. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Woo H. Choi  
February 10, 2005